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WOODCOCK WASHBURN LLP ONE LIBERTY PLACE - 46TH FLOOR PHILADELPHIA, PA 19103			SHIFERAW, ELENI A	
			ART UNIT	PAPER NUMBER
			2136	
DATE MAILED: 11/02/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,318

Applicant(s)

ABBURI ET AL.

Examiner

Eleni A Shiferaw

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892) *
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/20/2001.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

1. Claims 1-26 are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 5, 8, 16-17, 23-24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Story, JR. et al. (Story, Pub. No.: US 2002/0046181 A1) in view of Benson et al. (Benson, Patent No.: US 6,678,665 B1).

As per claim 1, Story teaches a method of enabling the use of a digital license on a plurality of devices (Story Page 3 par. 0039, Fig. 5; digital license created by license management device is stored in one or more playback devices or computers), said digital license permitting the use of a content item and being bound to a first of said plurality of devices by a first key pair associated with said first device (Story Page 1 par. 0016; encrypted digital license are stored in playback devices), said method comprising:

receiving a first digital license from said first device (Story Page 2 par. 0022; receiving a digital license from license management server);

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receiving a second key pair associated with a second of said plurality of devices, said second key pair being different from said first key pair (Story Page 4 Claim no. 3; second digital license is stored in the second device; and Page 4 par. 0052, digital license stored in the device is encrypted and it is obvious that the second device receives the second key pair different from the first key pair because it would prevent an authorized copy of digital content);

creating a second digital license bound to said second device using said second key pair (Story Page 4 Claim no. 3; creating a second license and second license is stored in the second device; Page 4 par. 0052 license stored in different devices are encrypted it is obvious that different key pair is used if license is encrypted because it would prevent an authorized copying of digital content); and

transmitting said second digital license to said second device (Story Page 4 Claim no. 3; digital license is transmitted from license management server and stored in the second device);

Story does not explicitly teach said second digital license being based on said first digital license;

However Benson teaches generating a public and private key pair and the first key pair is associated with the second key pair (Benson Col. 11 lines 66-col. 12 lines 23);

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Benson with in the system of Story because it would allow to locate a certificate that holds the associated digital signature public keying material and then the software vendor may potentially execute some administrative action (Benson Col. 12 lines 24-37). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to apply the teachings of Benson with in the

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system of Story because it would locate the first digital license and provide service to a user to render the digital content on different computer devices without purchasing a duplicate license.

As per claim 17, Story teaches a method of enabling the use of a first digital license on a plurality of devices (Story Page 3 par. 0039, Fig. 5; digital license created by license management device is stored in one or more playback devices), said first digital license permitting the use of a content item and being bound to a first of said plurality of devices by a first key pair associated with said first device (Story Page 1 par. 0016; encrypted digital license are stored in playback devices), said method comprising:

 sending, to a license synchronization server, a second key pair associated with a second of said plurality of devices, said second key pair being different from said first key pair (Story Page 4 Claim no. 3; second digital license is transmitted from license management server and stored in the second device; and Page 4 par. 0052, digital license stored in the device is encrypted and it is obvious at the time of the invention was made that the second device receives the second key pair different from the first key pair because it would prevent an authorized copy of digital content); and

 receiving, from said license synchronization server, a second digital license bound to said second device by said second key pair (Story Page 4 Claim no. 3; receiving a second license and storing a second license on the second device; Page 4 par. 0052 license stored in different devices are encrypted it is obvious that different key pair is used if license is encrypted because it would prevent an authorized copying of digital content),

Story does not explicitly teach said second digital license being based on said first digital license

However Benson teaches generating a public and private key pair and the first key pair is associated with the second key pair (Benson Col. 11 lines 66-col. 12 lines 23);

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Benson with in the system of Story because it would allow to locate a certificate that holds the associated digital signature public keying material and then the software vendor may potentially execute some administrative action (Benson Col. 12 lines 24-37). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to apply the teachings of Benson with in the system of Story because it would locate the first digital license and provide service to a user to render the digital content on different computer devices without purchasing a duplicate license.

As per claim 24, Story teaches a system for roaming a digital license to a plurality of computing devices (Story Page 3 par. 0039, Fig. 5; digital license created by license management device is stored in one or more playback devices) comprising:

a receiving module which receives over a computer network (Story Page 3 par. 0036; playback device module receives over a computer network):

from a first of said plurality of computing devices (Story Page 3 par. 0039, Fig. 5; digital license created by license management device is stored in one or more playback devices), a first digital license which permits the use of a content item and is bound to said first of said plurality of computing devices by a first key pair associated with said first of said

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plurality of computing devices (Story Page 1 par. 0016; encrypted digital license are stored in playback devices); and

a second key pair associated with a second of said plurality of computing devices different from said first of said plurality of computing devices, said second key pair being different from said first key pair (Story Page 4 Claim no. 3, Page 4 par. 0052; an encrypted second digital license associated with a second of said plurality of computing devices is created it is obvious that different key pair is used for the second encrypted digital license because it would prevent an authorized copying of digital content);

a license-rewriting module which uses said second key pair to create a second digital license, said second digital license being bound to said second device (Story Page 2 par. 0028-0030, Page 4 Claim no. 3, and Page 4 par. 0052; license management module rewriting a second encrypted digital license to a second device); and

a transmitting module for transmitting said second license to said second device (Story Page 2 par. 0032, and Page 4 Claim no. 3; license management module transmitting said second license to said second device);

Story does not explicitly teach said second digital license being based on said first digital license;

However Benson teaches generating a public and private key pair and the first key pair is associated with the second key pair (Benson Col. 11 lines 66-col. 12 lines 23);

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Benson with in the system of Story because it would allow to locate a certificate that holds the associated digital signature public keying

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material and then the software vendor may potentially execute some administrative action (Benson Col. 12 lines 24-37). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to apply the teachings of Benson with in the system of Story because it would locate the first digital license and provide service to a user to render the digital content on different computer devices without purchasing a duplicate license.

As per claim 5, Story and Benson teach all the subject matter as described above. In addition Story teaches the method, further comprising: creating a third digital license; and transmitting said third license to said first device (Story Page 1 par. 16; creating a digital license and transmitting and storing it in one or more devices); and

Benson the first key pair is associated with the second key pair (Benson Col. 12 lines 16-23) that reads on a third digital license bound to said first device. The rational for combining are the same as claim 1 above.

As per claim 8, Story and Benson teach all the subject matter as described above. In addition Story teaches the method, further comprising the act of limiting the number of said plurality of devices (Story Page 3 par. 0039; digital license can be stored in one or mere devices).

As per claim 16 and 23, Story and Benson teach all the subject matter as described above. In addition Story teaches a computer-readable medium containing computer-executable instructions for performing the method (Story Page 2 par. 0028-0030).

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As per claim 26, Story and Benson teach all the subject matter as described above. In addition Story teaches the method, further comprising: a module which limits the number of said plurality of devices (Story Page 3 par. 0039; digital license can be stored in one or mere devices).

4. Claims 2-4, 6-7, 9-15, 18-22, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Story, JR. et al. (Story, Pub. No.: US 2002/0046181 A1) in view of Benson et al. (Benson, Patent No.: US 6,678,665 B1), and in further view of Yang et al. (Yang, Pub. No.: US 2002/0194008 A1).

As per claim 12, Story teaches a method of roaming a digital license onto a plurality of devices (Story Page 3 par. 0039, Fig. 5 No. 550, and 560; digital license is distributed to different devices), said roamed digital license enabling the use of a content item on a plurality of devices (Story Abstract), comprising:

receiving a first digital license cryptographically bound to a first device (Story Page 4 Claim no. 1, and Page 4 par. 0052; receiving an encrypted digital license by a first device;

transmitting said second license to said first device (Story Page 4 Claim no. 3; digital license is transmitted from license management server and stored in the second device)

Story does not explicitly teach creating a second digital license cryptographically bound to said first device,

However Benson teaches generating a public and private key pair and associating the second key pair with the first key pair (Benson Col. 11 lines 66-col. 12 lines 23);

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Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Benson with in the system of Story because it would allow to locate a certificate that holds the associated digital signature public keying material and then the software vendor may potentially execute some administrative action (Benson Col. 12 lines 24-37). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to apply the teachings of Benson with in the system of Story because it would locate the first digital license and provide service to a user to render the digital content on different computer devices without purchasing a duplicate license.

Story and Benson do not explicitly teach said first digital license having a first set of terms;

said second digital license having a second set of terms different from said first set of terms;

However Yang discloses a software license with a set of terms that reads on said first digital license having a first set of terms (Yang Abstract);

Yang also teaches the possibility of storing information pertaining to multiple contracts in a system with each contract potentially having different terms that reads on said second digital license having a second set of terms different from said first set of terms (Yang Page 5 par. 0045);

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Yang with in the combination system of Story and Benson because it would allow to specify the digital license contract rules and govern how the digital license contract is to be fulfilled (Yang Page 4 par. 0039). Therefore it would

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have been obvious to one ordinary skill in the art at the time of the invention was made to have different set of terms in a first digital license and a second digital license because it would allow a periodic contact with a license synchronization server in order to update the expiration date on the copy/replacement license, and governs how long the computing device will stay on a list of active registered devices.

As per claim 2, and 18, Story and Benson teach all the subject matter as described above.

Story and Benson do not explicitly teach wherein said first digital license includes a first expiration date,

However Yang teaches the method, duration of a digital license that reads on wherein said first digital license includes a first expiration date (Yang Page 1 par. 0007, and 10 par. 0091).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Yang with in the combination system of Story and Benson because it would allow to select digital license contract terms and satisfy user needs (Yang Page 4 par. 0039). Therefore it would have been obvious to one ordinary skill in the art at the time of the invention was made to include expiration date on the first digital license because it would limit time to access digital content.

As per claim 3, and 19, Story, Benson and Yang teach all the subject matter as described above.

In addition Yang teaches the method, wherein said act of creating a second digital license includes adding a second expiration date to said second digital license (Yang Page 1 par. 0007,

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and10 par. 0091), said second expiration date occurring earlier in time than said first expiration date (Yang Page 5 par. 0045);

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Yang with in the combination system of Story and Benson because it would allow to specify the digital license contract rules and govern how the digital license contract is to be fulfilled (Yang Page 4 par. 0039). Therefore it would have been obvious to one ordinary skill in the art at the time of the invention was made to have second expiration date occurring earlier in time than the first expiration date because it would allow a periodic contact with a license synchronization server in order to update the expiration date on the copy/replacement license, and governs how long the computing device will stay on a list of active registered devices.

As per claim 4, Story, Benson and Yang teach all the subject matter as described above. In addition Yang teaches the method, wherein said second expiration date comprises a specified offset from a date on which said act of transmitting said second digital license occurs (Yang Page 4 par. 0038). The rational for combining are the same as claim 3 above.

As per claim 6, Story, Benson, and Yang teach all the subject matter as described above. In addition Yang teaches a method, duration of a digital license that reads on wherein said third digital license includes a first expiration date (Yang Page 1 par. 0007, and10 par. 0091). The rational for combining are the same as claim 2 above.

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As per claim 7, Story, Benson, and Yang teach all the subject matter as described above.

In addition Yang, wherein said first expiration date comprises a specified offset from a date on which said act of transmitting said third license occurs (Yang Page 4 par. 0038). The rationale for combining are the same as claim 3 above.

As per claim 9, Story, Benson, and Yang teach all the subject matter as described above.

In addition Yang, wherein said second digital license includes a first expiration date (Yang Page 4 par. 0038), and each of said third digital licenses including a second expiration date different from said first expiration date (Yang Page 5 par. 0045). The rationale for combining are the same as claim 12 above.

Benson teaches a method for digital license, the first key pair associated with the second key pair that reads on a second digital license with one or more third digital licenses based on said first digital license (Benson Col. 12 lines 17-23),

Yang wherein said method further comprises the act of periodically refreshing said second digital license with one or more third digital licenses (Yang Page 5 par. 0051-Page 6 par. 0052; duration of time for digital license is given, digital license can be canceled, and digital license can be re-placed),

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Yang with in the combination system of Story and Benson because it would allow to end or cancel a digital license authorization (Yang Page 6 par. 0052)

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As per claim 10 and 22, Story, Benson, and Yang teach all the subject matter as described above.

In addition Yang, further comprising revoking said second digital license (Yang Page 5 par. 0051-Page 6 par. 0052).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Yang with in the combination system of Story and Benson because it would allow to cancel to re-assign a digital license authorization (Yang Page 6 par. 0052).

As per claim 11, Story, Benson, and Yang teach all the subject matter as described above.

In addition Yang, further comprising re-assigning said second digital license to a third of said plurality of devices after said revocation of said second digital license (Yang Page 5 par. 0051-Page 6 par. 0052).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Yang with in the combination system of Story and Benson because it would allow to re-assign a digital license to a user (Yang Page 6 par. 0052).

As per claim 13, Story, Benson, and Yang teach all the subject matter as described above.

In addition Yang, wherein said first set of terms includes a first expiration date, and wherein said second set of terms includes a second expiration date different from said first expiration date (Yang Fig. 5C No. 534). The rational for combining are the same as claim 12 above.

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As per claim 14, Story, Benson, and Yang teach all the subject matter as described above.

In addition Yang, wherein said second expiration date comprises a date which is a specified offset from a date on which said act of creating said second digital license occurs (Yang Page 4 par. 0038). The rational for combining are the same as claim 3 above.

As per claim 15, Story, Benson, and Yang teach all the subject matter as described above.

In addition Yang, further comprising the act of periodically replacing said second license on said first device (Yang Page 6 par. 0052; canceling digital license and re-assigning it).

As per claim 20, Story, Benson, and Yang teach all the subject matter as described above.

In addition Yang, wherein said second expiration date comprises a specified offset from a date on which said act of receiving said second digital license occurs (Yang Page 4 par. 0038). The rational for combining are the same as claim 3 above.

As per claim 21, Story, Benson, and Yang teach all the subject matter as described above.

In addition Yang, wherein said second digital license has a set of license terms and a first expiration date (Yang Page 4 par. 0038), and wherein said method further comprises periodically receiving a replacement of said second digital license, wherein each of the periodic replacements has said set of license terms (Page 5 par. 0046) and a second expiration date different from said first expiration date (Yang Page 5 par. 0045). The rational for combining are the same as claim 12 above.

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As per claim 25, Story, Benson, and Yang teach all the subject matter as described above.

In addition Yang, further comprising: a transmitting module which periodically transmits a refreshed second license to said second device (Yang Page 6 par. 0052). The rationale for combining are the same as claim 9 above.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni A Shiferaw whose telephone number is 571-272-3867. The examiner can normally be reached on Mon-Fri 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Eleni Shiferaw
Art Unit 2136


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